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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/559,784

12/08/2005

Mitsuko Kosaka

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8189

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EXAMINER

DUTT, ADITI

ART UNIT

PAPER NUMBER

1649

MAIL DATE

DELIVERY MODE

10/09/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	Application No. 10/559,784	Applicant(s) KOSAKA, MITSUKO	
	Examiner Aditi Dutt	Art Unit 1649	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 September 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 7 and 8.
- Claim(s) withdrawn from consideration: 1-6, 11-14.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See continuation below.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Jeffrey Stucker/
Supervisory Patent Examiner, Art Unit 1649

/A. D./
Examiner, Art Unit 1649

Continuation of 11: Does not place the application for condition of allowance because:

The rejection of claims 7-8 as being unpatentable over Kosaka et al. (Exp Cell Res 245: 245-251, 1998) in view of Haruta et al., (Nat Neurosc 4: 1163-1164, 2001) is maintained for reasons of record in the last Office Action dated 7/15/09.

Applicant argues that the expression of neurofilament 200 (NF 200) in cells does not necessarily mean that these cells are retinal ganglion cells, especially because NF200 is expressed in many nerves. Applicant further alleges that Haruta et al do not describe the differentiation of iris pigment epithelial cells (IPE) to retinal ganglion cells. Applicant further argues that neural IPE cells can differentiate to retinal nerve cells was not known at the time of filing of the present application, "regardless of the fact that IPE cells and retinal nerve cells have common developmental origin". Applicant points out to the treatise by the present inventors that states the difficulty of inducing retinal cells from retinal pigment epithelial, further asserting the absence of cells positive for a photoreceptor cell marker. Applicant emphasizes that the obviousness rejection is incorrect based on the Graham factors particularly with respect to the aspect of predictability. Applicant concludes that at the time of filing of the instant Application, a person of ordinary skill "could not predict that IPE cells can be differentiated into retinal nerve cells although IPE cells and retinal nerve cells have a common developmental origin".

Applicant's arguments are fully considered but not found to be persuasive. Like the teachings of the treatise currently provided by Applicant, Haruta et al also teach that the cells do not express rhodopsin, a marker for rod photoreceptors. It is to be noted that the treatise teaches differentiation of retinal pigmented epithelial cells (RPE) and not IPE cells, as instantly claimed or as taught by Haruta et al. Even if the difference is disregarded, this issue is moot because arguments that rely on particular distinguishing features are not persuasive when those features are not recited in the claims, i.e. the claims do not require the differentiation to retinal photoreceptor cells. It is further reiterated that a retinal nerve cell can comprise a retinal visual cell, bipolar cell, Muller glial cells, etc. (instant specification, para 0040). Applicant is again reminded that "while the claims are to be interpreted in light of the specification, it does not follow that limitations from the specification may be read into claims. On the contrary, claims must be interpreted as broadly as their terms reasonably allow. See *Ex parte Oetiker*, 23 USPQ2d 1641 (BPAI, 1992). Please note that the claims define the subject matter of his invention and that the specification cannot be relied upon to read limitations into the claims.

Furthermore, although NF200 is a marker for many different nerves, the Haruta reference clearly implies that IPE cells expressing NF200 can promote retinal cell differentiation. The fact that Haruta teachings suggest the differentiation of IPE cells to retinal cells or retinal nerve cells and the fact that NF200 can be a marker for retinal nerve cells, contradicts Applicant's allegation that this knowledge was unknown at the time of filing of the application, and thereby one could not predict such differentiation. Furthermore, obviousness does not require absolute predictability, only a reasonable expectation of success, i.e., a reasonable expectation of obtaining similar properties. See, e.g., *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir.1988). Based upon the combined teachings and suggestion of the prior art, the person of ordinary skill in the art would have been motivated to try because IPE and the neural retina have a common developmental origin. As the source of the cells and the culture conditions in the prior art teachings and the currently claimed invention are the same, the claimed invention as a whole stands *prima facie* obvious over the combined teachings of the prior art and stay rejected.